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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/903,770 07/13/01 MOECKEL

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EXAMINER

022850 HM22/1109
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ART UNIT	PAPER NUMBER

1652
DATE MAILED:

6

11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/903,770

Applicant(s)

Moeckel et al.

Examiner
Christian L. Fronda

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED/STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19, 37, and 38, drawn to an isolated polynucleotide, vector, host cell, and a method for making the LysR1 protein, classified in class 435, subclass 69.1.
 - II. Claims 20 and 21, drawn to a Coryneform bacterium comprising an attenuated lysR1 gene, classified in class 435, subclass 252.3.
 - III. Claim 3, drawn to *Escherichia Coli* DSM 13616, classified in class 435, subclass 252.33.
 - IV. Claims 23-28, drawn to a process for producing L-amino acids using a bacterial cell comprising an attenuated lysR1 gene, classified in class 435, subclass 115.
 - V. Claims 23 and 29, drawn to a process for producing L-amino acids using a bacterial cell comprising an attenuated lysR1 gene and one gene whose expression is enhanced, wherein said gene is selected from the group consisting of dapA, eno, zwf, pyc, and lysE, classified in class 435, subclass 115.
 - ~~VI. Claims 23 and 30, drawn to a process for producing L-amino acids using a bacterial cell comprising an attenuated lysR1 gene and one gene whose expression is attenuated, wherein said gene is selected from the group consisting of pck, pgi, and poxB, classified in 435, subclass 115.~~
 - VII. Claims 31 and 32, drawn to a process for screening for polynucleotides which encode a protein having LysR1 transcriptional regulatory activity by hybridizing a polynucleotide, classified in class 435, subclass 6.
 - VIII. Claims 33 and 35, drawn to a method for detecting a nucleic acid by hybridizing a probe or primer to a nucleic acid sample, classified in class 435, subclass 6.
 - IX. Claims 34 and 36, drawn to method for producing nucleic acid which is at least 70% homologous to SEQ ID NO: 1, classified in class 435, subclass 6.
 - X. Claim 39, drawn to an isolated polypeptide comprising the amino acid sequence

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of SEQ ID NO: 2, classified in class 530, subclass 350.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-III and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The products of Groups I-III and X are independent chemical entities and require different literature searches.

Inventions of Groups IV-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups IV-IX are distinct both physically and functionally and require different process steps, reagents, and parameters.

The inventions of Groups II, III, and X are unrelated to the inventions of Groups IV-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the processes of Groups IV-IX do not require the products of Groups II, III, and X.

Inventions I and IV-IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the polynucleotide in a recombinant process for producing a recombinant polypeptide.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Claims 29 and 30 are generic to a plurality of disclosed patentably distinct species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

If Group V (claims 23 and 29) is elected, then Applicants are required to elect one gene selected from the group consisting of *dapA*, *eno*, *zwf*, *pyc*, and *lysE* for examination.

If Group VI (claims 23 and 30) is elected, then Applicants are required to elect one gene selected from the group consisting of *pck*, *pgi*, and *pgi* for examination.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF


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